



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/135,988 08/17/98 BRYAN B 24729-1050

STEPHANIE SEIDMAN
HELLER EHRMAN WHITE & MCAULIFFE
4250 EXECUTIVE SQUARE
7TH FLOOR
LA JOLLA CA 92037

HM12/1105

EXAMINER

WAX, R

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

11/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/135,988

Applicant(s)

Bryan

Examiner

Robert A. Wax

Group Art Unit
1652



☒ Responsive to communication(s) filed on Aug 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-5, 10-19, 30-32, 46, 47, and 59-68 is/are pending in the applicat

Of the above, claim(s) 10 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-5, 11-19, 30-32, 46, 47, 59, and 62-68 is/are rejected.

☒ Claim(s) 2, 60, and 61 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1652

DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I and glowing paper products in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). In the new claims a second number 64 follows 65. In accordance with Rule 126 the second claim 64 was renumbered as 66, the second 65 was renumbered as 67 and 66 was renumbered as 68. Since claim 10 is drawn to a cosmetic it is held nonelected; thus, claims 1-5, 11-19, 30-32, 46-47 and 59-68 are under consideration.

Information Disclosure Statement

2. The information disclosure statement filed June 15, 1999 has been considered. Please see the attached PTO-1449s.

Claim Objections

3. Claim 47 is objected to because of the following informalities: this claim depends from claim 100 rather than 1. Appropriate correction is required.

Art Unit: 1652

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 62-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 62 "comprises components a coelenterate" makes no sense. In claim 63 "is selected *Renilla*" should read "is selected from the group consisting of". Claims 64-66 contain the same construction.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-5, 11-19, 30-32, 46-47, 59 and 62-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd et al. in view of common knowledge.

Art Unit: 1652

Lloyd et al. teach a paper (column 1, line 51) apron made of luminescent material at column 2, line 49). Claim 2 recites light reflective coating. Various bioluminescent compositions and methods of applying them are notoriously well known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply any of the known bioluminescent coatings onto the apron of Lloyd et al. as the luminescent material clearly contemplated by Lloyd et al. with the expectation of making a suitable product. Motivation for using bioluminescence rather than any other material might be to use the bioluminescent host cell to also overproduce and secrete cellulose-degrading enzymes, thus making a self-biodegrading product.

Allowable Subject Matter

8. Claims 2, 59 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach luminescent (bioluminescent or otherwise) wrapping paper or greeting cards; thus the above claims are allowable over the prior art of record.

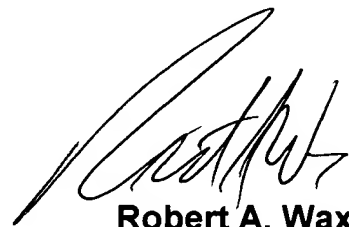
9. No claim is allowed.

Art Unit: 1652

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (703) 308-4216. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy, can be reached on (703) 308-3804. The OFFICIAL fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Robert A. Wax
Primary Examiner
Art Unit 1652